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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,685	04/27/2001	Shuhei Yamamoto	N9450.0013/P013	9040
24998	7590	10/05/2004		
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L STREET NW WASHINGTON, DC 20037-1526			EXAMINER CHOI, LING SIU	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/842,685

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

Ling-Siu Choi

**Art Unit**

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/27/2001</u> . | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Claims 1-3 are now pending, wherein claims 1-2 are drawn to an electrophoresis apparatus and claim 3 is drawn to a sample plate assembly.

### ***Claim Objections***

2. Claims 1-3 are objected to because of the following informalities: **claim 1**, lines 11, 12, and 14; **claim 3**, lines 4, 5, and 7, "septer" is suggested to be changed to --septum-- because septer is not a English word.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Moring et al. (US 5,384,024).

The present invention relates to **an electrophoresis apparatus** in which a sample marked by fluorescent material is separated in capillaries through electrophoresis by making use of capillary array formed by a plurality of capillaries; fluorescence emission is caused by irradiation light to the sample and through detection of the fluorescence the sample is analyzed, comprising

a sample plate assembly	two sets of a tray at a sample supply portion
	an adapter for the tray
	a sample plate mounted on the adapter
	a septer mounted on the sample plate and a septer cover mounted on the septer
wherein two sample plates include respectively different number of wells; and the tray, the adapter, the septer, and the septer holder in each set being adapted to the corresponding different sample plate	

(summary of claim 1)

Moring et al. disclose an **capillary electrophoresis** comprising a rotary carousel having multiple circular locations for liquid containers, wherein the carousel is translatable as well rotatable and wherein a removable tray facilitate loading and unloading groups of sample containers and buffers container to the instrument, which are closed by a unique flexible **septum** with a duck-billed portion extending toward the container it closes, permitting easy entry of a capillary end and an electrode, while protecting the contents from contamination and evaporation (col. 2, lines 67-68; col. 3, lines 1-4, 9-13, and 39-41; claim 1). Attention is drawn to Figures 4-5, wherein the tray

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is divided into two portions having **unequal numbers of containers** (col. 6, lines 25-60). Thus, the present claims are anticipated by the disclosure of Moring et al..

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kane et al. (US 5,916,428).

Kane et al. disclose a capillary electrophoresis, wherein samples in wells of tray can be simultaneously undergo electrophoresis separation and needles are secured to the cylindrical inner walls of the compression fitting with an epoxy sealant, the fitting being formed from nylon into which the need is inserted (abstract; col. 6, lines 41-53). However, Kane et al. do not teach or fairly suggest a capillary electrophoresis comprising septum and trays containing the unequal numbers of wells.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is (571-272-1098. The examiner can normally be reached on Monday to Friday.

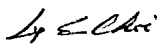
If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**LING-SUI CHOI**  
**PRIMARY EXAMINER**

Ling -Siu Choi, Ph.D.

September 27, 2004